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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,014	02/08/2005	Aurelio Romeo	5098-0101PUS1	7574

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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MAHAFKEY, KELLY J

ART UNIT	PAPER NUMBER
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1761

NOTIFICATION DATE	DELIVERY MODE
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05/17/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

## Office Action Summary

**Application No.**

10/524,014

**Applicant(s)**

ROMEO, AURELIO

**Examiner**

Kelly Mahafkey

**Art Unit**

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24,25,27-32,35 and 37-68 is/are pending in the application.
- 4a) Of the above claim(s) 57-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24,25,27-32,35 and 37-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

Amendments made 3/1/07 have been entered.  
Claims 24, 25, 27-32, 25, 27-68 remain pending.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/1/07 has been entered.

***Election/Restrictions***

Newly submitted claims 57-68 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Previous presented claims 24, 25, 27-32 are drawn to composition made from a tomato juice or pastas, classified in class 426, subclass 599. Newly presented claims 57-68 are drawn to a method of making a tomato serum, classified in class 426, subclass 628. The inventions do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special feature linking the two inventions is a composition made from a tomato juice or tomato pastas which does not provide a contribution over the prior art.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 57-68 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. It is noted that a similar Election/Restriction requirement was made 12/21/05 between two sets of claims, one drawn to a product and one drawn to a method.

### ***Specification***

Applicant's specification is absent of appropriate headings and titles. Applicant is referred to the following for guidance in correcting the specification:

#### **Content of Specification**

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
  - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
  - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (d) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the

Art Unit: 1761

- invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (e) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (f) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 25, 27-32, 35, 40, 42, 44, and 56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 25 recites that the tomato composition contains "20-30% water insoluble solids" and "70-80% water soluble solids". Similarly, claim 56 recites, "tomato composition having a content of water-insoluble solids in the dry residue in the range from 20% to 30%" Although applicant has support for certain ranges of the insoluble and soluble solids within the

Art Unit: 1761

tomato composition, applicant does not have support for 20-30% water insoluble solids and/or 70-80% water soluble solids.

***Claim Rejections - 35 USC § 112 2<sup>nd</sup> Paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 45-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 45 recites, "A tomato composition prepared from tomato juice previously treated to inactivate enzymes or tomato passatas..." It is unclear as to if the tomato composition is prepared from tomato juice or tomato pastas which have been treated to inactivate enzymes, or as to if the tomato composition is prepared from tomato juice treated to inactivate enzymes or tomato passatas.

Claim 45 recites "A tomato composition prepared from tomato juice previously treated to inactivate enzymes or tomato passatas by a process comprising separation of tomato serum from water insoluble solids using a separation solid-liquid apparatus wherein the suspension to be filtered is maintained under stirring at an angular speed from 1rpm to 20rpm, the stirrer being of a shape to convey the suspension toward the central axis of the apparatus." It is unclear if the "tomato composition" is the tomato serum, the water insoluble solids, or some other product.

Claim 45 recites the limitation "the suspension to be filtered" in claim 45. There is insufficient antecedent basis for this limitation in the claim.

Claim 50 recites the limitation "sieve" in claim 45. There is insufficient antecedent basis for this limitation in the claim.

Claim 52 recites the limitation "the moving part" in claim 45. There is insufficient antecedent basis for this limitation in the claim.

Claim 55 recites the limitation "dry residue" in claim 45. There is insufficient antecedent basis for this limitation in the claim.

Claim 56 recites, "wherein *to* tomato compositions having a content of water insoluble solids in the dry residue in the range from 20% to 30% *is added lyophilized or cryoconcentrated serum or serum concentrated by osmosis membrane or by evaporation under vacuum.*" It is unclear as to if "two tomato compositions are combined" or if "the tomato composition is treated by evaporation to form dry residue", or if there is some other interpretation of the claimed phrase.

The 112 second paragraph rejections of claims 35 and 36 have been withdrawn in light of applicant's amendments made 3/1/07.

***Claim Rejections - 35 USC § 102***

The 102(b) rejection of claims 24-30, 33, 34, and 37 as being anticipated by Glasser et al. (US 4140809) has been withdrawn in light of applicant's amendments made 3/1/07.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 24, 25, 27-30, 37-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glasser (US 4140809) in view of Tanglerpaibul (XP 002043494).

Glasser teaches of a soup concentrate derived from vegetable matter, including tomatoes (i.e. Glasser teaches of a tomato composition). Glasser teaches that the tomato composition is obtained from tomato juice. Refer specifically to Abstract and Example 2. Glasser teaches that the soup concentrate is mixed with approximately 3-10 parts water (Column 3 lines 9-22) to form a final composition. Glasser teaches that the concentrate composition contains 20-40% soluble solids based on the soup concentrate (Claim 1). Glasser teaches that the soup concentrate has a moisture content of 40-60% (Column 4 lines 9-23). Glasser teaches that the tomato composition, when in final form (i.e. the tomato concentrate when mixed with water) has a moisture content of 85-96%, and thus a solids/dry residue content of 4-15%. Glasser teaches that the tomato composition contains 33.3-100% soluble solids and 0-66.6% insoluble

solids based on the weight of the total solid/dry residue content. Regarding the dry residue, moisture, insoluble solids, and soluble solids content, as calculated by the examiner (See the Office Action mailed 11/1/06) and by the applicant (Remarks 3/1/07), the tomato composition as taught by Glasser contains 85-96% moisture based on the final composition, 4-15% dry residue based on the final composition, about 33.3-67.7% soluble solids based on the dry residue in the final composition, and about 32.2-66.6% insoluble solids based on the dry residue in the final composition.

Glasser teaches that one would modify the amount of soluble and insoluble solids depending on the desired freezing properties of the soup concentrate (Abstract, Column 1 lines 19-52, Column 2 lines 53-68, and Column 3 lines 1-12). Glasser teaches of the vegetable composition in admixture with animal and vegetable fats which are solid or liquid at room temperature (Examples 1-3). Glasser teaches that the meat and/or preservatives, such as salt can be added to (i.e. sauced by) the tomato composition (Abstract).

Glasser, does not explicitly teach the composition as including 18-30% or 20-30% water insoluble solids and 80-94.5% or 70-80% water soluble solids, based on the total solids content as recited in claims 24 and 25, to the soup concentrate or soup composition as a ready to use sauce for food as recited in claims 39 and 40 or a food comprising the tomato composition as recited in claims 43 and 44.

Regarding the composition as including 18-30% or 20-30% water insoluble solids and 80-94.5% or 70-80% water soluble solids, based on the total solids content as recited in claims 24 and 25, Glasser teaches the tomato composition contains about 33-68% soluble solids based on the dry residue in the final composition, and about 32-67% insoluble solids based on the dry residue in the final composition. Tanglertpaibul teaches that it was known to decrease the amount of water-insoluble solids in a tomato composition in order to decrease the viscosity and visa versa (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to increase the amount of water insoluble solids in the tomato composition as taught by Glasser in order to increase the viscosity of the final product. To increase a known



Art Unit: 1761

ingredient for a known intended result does not provide a patentable distinction to the claims absent any clear and/or convincing evidence and/or arguments to the contrary.

Regarding the soup concentrate or soup composition as a ready to use sauce for food as recited in claims 39 and 40, it was known at the time the invention was made that soup concentrates and soup compositions were utilized as base mixtures for creating meals such as casserole dishes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the tomato composition in a specific manner depending on the meal to be prepared. One would have been motivated to use the tomato composition as a ready to use sauce in the preparation of a casserole dish.

Regarding a food comprising the tomato composition as recited in claims 43 and 44, at the time the invention was made, it was known to serve soups in both traditional bowls (i.e. non-edible) as well as through edible means, such as bread bowls. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the tomato soup composition into a food depending on the desired serving means for the composition. One would have been motivated to use edible serving means, such as a bread bowl in order to reduce the amount of dishes to be washed after the meal was finished.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glasser (US 4140809) in view of the Benefits ("The Benefits of Olive Oil"). The references and rejection are incorporated herein and as cited in the office action mailed November 11, 2006.

Claims 32, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glasser (US 4140809), in view of Terrytx (Creamy Tomato Cheese Soup, 1999 Recipelink.com). The references and rejection are incorporated herein and as cited in the office action mailed November 11, 2006.

Claims 24, 25, and 45-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bueno (EP 0888718 A1).

Bueno teaches of a tomato composition prepared from tomatoes containing tomato juice, by a process comprising heating the tomatoes to inactivate enzymes and separation of tomato serum from water insoluble solids using a separation solid-liquid apparatus wherein the tomato juice is maintained under stirring (Abstract). Bueno teaches that the separation can be achieved with a sieve with a paddle type extractor (i.e. a vessel having walls with slots or holes). Bueno teaches that the sieve holes are 0.6-2.2mm and that the sieve operates at different speeds depending on the apparatus utilized. Bueno teaches that a paddle type extractor operates at 100-500rpm. Bueno teaches that the separation holes are from 0.6-2.2mm in diameter. Bueno teaches that the insoluble material separated is macerated to particles with a diameter of less than 0.15mm and then recombined with the tomato serum. Bueno teaches that the stirrer in the separation apparatus can be near the wall to force the tomato against the screen or can allow the tomato to naturally press against the screen. Refer specifically to Page 4 line 1 through Page 5 line 19. Bueno teaches that the separation is performed at room temperature and atmospheric pressure (Example 1). Bueno teaches that the composition includes about 24% water insoluble solids based on the total solids (Example 1 Table 3:  $((90.1\% \text{ Water Soluble Matter}) / (90.1\% \text{ Water Soluble Matter} + 28.98\% \text{ Dry Matter})) = \text{about } 24\% \text{ water insoluble solids based on the weight of the total solids}$ ).

Bueno does not specifically teach the tomato composition as including 5.5-20% dry matter as recited in claim 24, the tomato composition as sterilized or processed under sterile conditions as recited in claim 47, and the separation apparatus hole diameters as not greater than 0.1mm as recited in claims 49, 50, and 51.

Specifically regarding the tomato composition as including 5.5-20% solids, Bueno teaches that the tomato composition has a solids content of about 28%. It was known in the art at the time the invention was made to adjust the water content of vegetable paste and juice products depending on the desired sugar content per serving, solid content per serving (i.e. the amount of pulp), and water content per serving. It would have been obvious to one of ordinary skill in the art at the time the invention was made to increase the water content of the tomato composition in order to decrease the

Art Unit: 1761

amount of sugar per serving of the tomato composition (i.e. in order to reduce the calorie content of the composition) and/or the amount of pulp per serving in the tomato composition (i.e. in order to form a composition with a more smooth texture), and/or to increase the water content of the tomato composition (i.e. in order to form a mixture which would better hydrate the consumer).

Specifically regarding the tomato composition as sterilized or processed under sterile conditions, it was known in the art at the time the invention was made to sterilize food made for human consumption. Since the product produced by Bueno is intended for human consumption (Page 2- State of the Art), one of ordinary skill in the art at the time the invention was made would have been motivated to sterilize it in order to prevent the consumption of non-sterile material which could cause sickness to the consumer.

Specifically regarding the separation apparatus with holes diameters not greater than 0.1mm, Bueno teaches that the separation holes are from 0.6-2.2mm in diameter. Bueno teaches that the insoluble material separated is macerated to particles with a diameter of less than 0.15mm and then recombined with the tomato serum. Since Bueno teaches that the insoluble materials reintroduced into the tomato serum are of a diameter less than 0.15mm, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the separation hole diameters to also be less than 0.15mm, including less than 0.1mm, in order to form a smooth consistent product.

Applicant is reminded that "Patentability shall not be negated by the manner in which the invention was made" and that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Specially regarding the process as including separation with a solid-liquid apparatus at an angular speed (i.e. a rotational speed) of 1-20rpm or 2-10rpm, Bueno

Art Unit: 1761

teaches that the process includes separation with a solid-liquid apparatus at a rotational speed of 100rpm. One of ordinary skill in the art at the time the invention was made would expect the product separated by an apparatus at 1-20rpm, including 2-10rpm, to be similar to the product separated by an apparatus at 100rpm, as one of ordinary skill would expect the revolutions per minute or oscillations per minute of the sieve separation apparatus to affect the processing parameters (i.e. such as processing time, the speed at which the composition was separated, the amount of cleaning of the sieve holes required during processing, ect) and not materially affect the product produced, absent any clear and/or convincing arguments and/or evidence to the contrary.

Specifically regarding the process as including a concave or flat shaped sieve made out of a specific material, with a specific diameter, and with specific slot lengths, one of ordinary skill in the art would not expect the size or shape or material of the sieve to materially affect the product produced, absent any clear and/or convincing arguments and/or evidence to the contrary. Similarly, one of ordinary skill in the art would not expect the slot lengths of the sieve to materially affect the product produced, absent any clear and/or convincing arguments and/or evidence to the contrary.

### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection as stated above.

### ***Conclusion***

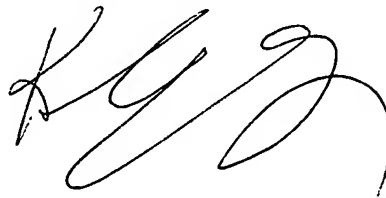
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Mahafkey whose telephone number is (571) 272-2739. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1761

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kelly Mahafkey  
Examiner  
Art Unit 1761



**KEITH HENDRICKS**  
**PRIMARY EXAMINER**